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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,544	07/25/2000	Edmund A. Hebert	174-893	6950

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EXAMINER

LEE, EDMUND H

ART UNIT PAPER NUMBER

1732

DATE MAILED: 12/19/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/625,544

Applicant(s)

HEBERT ET AL.

Examiner

EDMUND H LEE

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No.

6132324. U.S. Patent No. 6132324 teaches all of the claimed limitations. The step of injection molding inner cover layer of U.S. Patent No. 6132324 is within the metes and bounds of the claimed step of forming the inner cover layer.

3. Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6132324 (hereinafter '324) in view of Sullivan et al (USPN 6015356). '324 teaches all of the claimed limitations except compression molding the inner cover layer. Sullivan et al teach a multi-layer golf ball having an inner most cover layer, wherein the innermost cover layer is compression molded or injection molded (col 30, ln 40-63). '324 and Sullivan et al are analogous because they are both related to molding golf balls having a

Art Unit: 1732

multi-layered cover. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the compression molding of Sullivan et al for the injection molding of '324 in order to produce balls having various layer thickness.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3-11, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Sullivan et al (USPN 6015356). Sullivan et al teach all of the claimed limitations. The use of a castable, ~~thermosetting~~ polyurethane by Sullivan et al to form the outer cover layer constitutes the claimed step of casting an outer cover layer. See col 23, lns 35-42. For claims 3-5, see col 31, ln 30- col 32, ln 30. For claim 6, see col 9, ln 60-col 17, ln 23. For claims 7-9, see col 10, lns 25-50. For claims 10-11, see col 31, ln 30-col 32, ln 30. For claim 17, see col 31, ln 30-col 32, ln 30. For claim 18, see col 22, ln 65-col 23, ln 41. For claim 19, see col 25, ln 59-65.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1732

7. Claims 2 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al (USPN 6015356) as applied to claim 1 above and further in view of Ward (USPN 3147324). The above teachings of Sullivan et al are incorporated hereinafter. Sullivan et al, however, does not teach the specific steps of casting the outer cover layer (claim 2); the specific steps of casting the outer cover layer (claim 12); allowing the thermoset to reside in the first mold for a specific amount of time (claim 13); causing the golf ball core to contact the thermoset material at a specific rate (claim 14); and using a thermoset material with a specific viscosity (claims 15-16). Ward teaches cast molding a thermosetting polyurethane cover layer onto a golf ball core (figs 1-5); mixing a prepolymer and a curing agent (col 3, ln 65-71; col 4, ln 35-62); filling mold halves with the prepolymer and curing agent (col 3, ln 65-71; col 4, ln 35-62); reacting the prepolymer and curing agent to form a polyurethane outer layer having a thickness (col 3, ln 65-71; col 4, ln 35-62); placing the golf ball core in a core holder (col 3, ln 65-71; col 4, ln 35-62; figs 1-5); gelling the thermoset material in the first mold half (col 3, ln 65-71; col 4, ln 35-62; figs 1-5); placing the golf ball core into the gelling thermoset material in the first mold half (col 3, ln 65-71; col 4, ln 35-62; figs 1-5); disengaging the golf ball core from the core holder after a selected period of time (col 3, ln 65-71; col 4, ln 35-62; figs 1-5); placing the golf ball core, while still in the first mold half with the thermoset material against a second mold half having additional thermoset material and mating the two mold halves together (col 3, ln 65-71; col 4, ln 35-62; figs 1-5); and curing the thermoset material in the mated mold halves (col 3, ln 65-71; col 4, ln 35-62;

Art Unit: 1732

figs 1-5). Sullivan et al and Ward are analogous because they are both related to using thermoset polyurethane to form an outer cover of a golf ball. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to cast mold the castable, thermosetting polyurethane of Sullivan et al by the process of Ward in order to efficiently mold a precise and accurate cover layer. In regard to allowing the thermoset to reside in the first mold for a specific amount of time (claim 13), gelling time is well-known in the molding art as important molding parameter and the desired gelling time would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, claimed gelling time is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the claimed polyurethane to reside for the claimed amount of time in order to ensure proper placement of the core of Sullivan et al (modified) within the polyurethane. In regard to causing the golf ball core to contact the thermoset material at a specific rate (claim 14), it is well-known in the molding art to lower a preform into a molding material at a rate sufficient to eliminate the formation of air bubbles. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to lower the core of Sullivan et al into the mold at the claimed rate in order to achieve the above result. In regard to using a thermoset material with a specific viscosity (claims 15-16), such is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process.

Art Unit: 1732

Further, the claimed viscosities are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the polyurethane to achieve the claimed viscosity before placing the core therein in order to ensure that the core would not move after being disengaged from the core holder.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shimosaka et al (USPN 5730665) teach compression molding or cast molding an inner cover layer.

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Edmund Lee whose telephone number is (703) 305-4019. The examiner can normally be reached on Monday-Wednesday and Friday from 8:00 AM to 4:00 PM. The fax number for Examiner Edmund Lee is (703) 872-9615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached on (703) 308-3829.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

EHL

December 13, 2002



Edmund Lee 12/13/02

Patent Examiner, AU 1732